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In the Supreme Court of the United States

OCTOBER TERM, 1949

No. 806

PAUL M. AMBROSE AND CRIMORA RESEARCH AND DEVELOPMENT CORPORATION, PETITIONERS

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The informal memorandum, findings of fact and conclusions of law of the District Court (R. 8-10) are not officially reported. The *per curiam* opinion of the Court of Appeals (R. 60) is not officially reported.

JURISDICTION

The judgment of the Court of Appeals was entered on February 6, 1950 (R. 61). The petition for writ of certiorari was filed on May 5, 1950. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether the court below erred in holding that there was no substantial evidence of "inadvertence, accident or mistake," as required for the reissue of a patent under Rev. Stat. 4916.

STATUTE INVOLVED

Rev. Stat. 4916, as amended (35 U.S.C. 64), provides in pertinent part:

> Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. * * *

STATEMENT

In their complaint in the District Court filed on March 27, 1947, under Rev. Stat. 4915, as amended (35 U.S.C. 63), petitioners asked that court to authorize the Commissioner of Patents to grant a reissue patent containing claims 19, 20, 21 and 30[1] of the Ambrose application Serial No. 368,310, for

[1] Claim 30 was withdrawn by petitioners at the trial (R. 9).

the reissue of the Ambrose patent No. 2,347,451 granted April 25, 1944, and entitled "Electrolytic Deposition of Manganese" (R. 2-5, 5-6).

After the Commissioner of Patents answered (R. 6-7) and a hearing had been held (R. 11-29), the district court found that the description of the invention as set forth in the reissue application was identical with that of the original patent (R. 9); that during the prosecution of the original application petitioners abandoned by cancellation claims 4 and 9 after their rejection by the examiner (R. 9); that these claims, taken together, contained substantially the same subject matter as that sought in the claims here involved (R. 9); and that the abandonment of these claims is conclusive that there was no inadvertence, accident or mistake within the meaning of Rev. Stat. 4916 (R. 9). The court, accordingly, ordered the complaint dismissed, holding (R. 10):

> In considering the right of a reissue applicant to obtain claims for subject matter substantially the same as that of claims abandoned in his original application, it is of no importance that the subject matter of the claims sought in the reissue was not entirely contained in a single abandoned claim, and that the subject matter abandoned was presented in more than one claim.

On appeal, the court below in a *per curiam* opinion affirmed, stating that "Quite apart from any question of estoppel, there was no substantial evi-

dence of the 'inadvertence, accident or mistake' required by R. S. § 4916, 35 U.S.C. § 64" (R. 60).

ARGUMENT

The court below affirmed the district court on the single ground that there was no substantial evidence to show that petitioners' error in making claims had arisen by inadvertence, accident or mistake. *Comstock* v. *Group of Institutional Investors,* 335 U. S. 211, 214. Such a question is not of general importance; on the contrary, it is primarily factual in nature, depending for its determination upon the particular circumstances of each case, including the actions taken by applicant's attorneys in the course of the proceedings before the Patent Office leading up to the issuance of the original patent and, in the usual case, upon a comparison of the original claims with those on which reissue is sought.

In the present case, the sole evidence in the record on this question is the oaths submitted by the applicant to the Patent Office in support of his reissue application (R. 32-33, 35-37). In the applicant's original reissue oath, it is stated that:

> * * * deponent is not skilled in the preparation and prosecution of patent applications and in the drafting and interpretation of patent claims and, accordingly, he relied upon his attorneys to present claims fully commensurate with the scope of his invention and in the light of the prior art; deponent believes that the attorneys were not fully aware

> of the scope of the claims to which he was and is entitled and failed to present [the] claims
> * * *

on which reissue is sought (R. 32-33).[2] These oaths are probably insufficient to make a showing of inadvertence, accident or mistake, since they set out only the applicant's conclusion and fail to specify the circumstances supporting that conclusion. See *General Radio Co.* v. *Allen B. Du Mont Laboratories,* 129 F. 2d 608, 611 (C.A. 3), certiorari denied, 317 U. S. 654; *Cridlebaugh* v. *Rudolph,* 131 F. 2d 795, 798 (C.A. 3), certiorari denied, 318 U. S. 779.

In any case, this conclusion is belied by the fact that the applicant's attorneys abandoned two claims which, taken together, it is now conceded (Pet. 3, 4, 7), cover substantially the same subject matter as the claims here sought on reissue. These abandoned claims indicate that the attorneys in fact understood the nature and scope of the applicant's invention and could have set up a claim to cover the asserted invention. Accordingly, their decision upon rejection to abandon these claims instead of amending the application to consolidate them did not constitute "inadvertence, accident or mistake" as that phrase is read in the cases cited by petitioner (Pet. 8-9), but involved a deliberate judgment, which is binding upon the applicant. *Leggett* v. *Avery,* 101 U. S. 256; *Manufacturing Co.*

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[2] Substantially the same statements are made in the supplemental reissue oath (R. 36-37).

v. *Ladd,* 102 U. S. 408; *Dobson* v. *Lees,* 137 U. S. 258; *General Radio Co.* v. *Allen B. Du Mont Laboratories,* 129 F. 2d 608, 611 (C.A. 3), certiorari denied, 317 U. S. 654; *Grand Rapids Show Case Co.* v. *Baker,* 216 Fed. 341 (C.A. 6); *In re Murray,* 77 F. 2d 651 (C.C.P.A.); *Arnheim* v. *Finster,* 24 Fed. 276 (C.C. S.D. N.Y.); cf. *Altoona Theatres* v. *Tri-Ergon Corp.,* 294 U. S. 477, 492-493; *Perfection Disappearing Bed Co.* v. *Murphy Wall Bed Co.,* 266 Fed. 698 (C.A. 9), certiorari denied, 254 U. S. 652.

The fact that, instead of one claim, two claims were combined together to show that the attorneys' actions were not accidental, does not impart general importance to this case as this situation has arisen relatively infrequently. Moreover, in the few instances that it has been presented for judicial decision, the courts have followed the same course. *Fiberjoint Corp.* v. *W. R. Meadows, Inc.,* 112 F. 2d 322, 323-326 (C.A. 7); *Union Switch & Signal Co.* v. *Louisville Frog Co.,* 73 F. 2d 550, 552 (C.A. 6); *In re Denton,* 12 App. D. C. 504; *In re Guastavino,* 83 F. 2d 913, 915-917 (C.C.P.A.). The approach so taken is, we believe, sound since the important consideration in deciding whether the action taken was deliberate or accidental is the attorneys' awareness of the significance of their actions; and on that issue, the nature of the subject matter abandoned is far more important than the number of claims among which the abandoned subject matter is distributed. Finally, this approach

serves as protection against the dangers of fraud inherent in permitting revival of abandoned subject matter. As pointed out in *Leggett* v. *Avery*, 101 U. S. 256, 259-260:

> * * * The allowance of claims once formally abandoned by the applicant, in order to get his letters-patent through, is the occasion of immense frauds against the public. It not infrequently happens that, after an application has been carefully examined and compared with previous inventions, and after the claims which such an examination renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have been appointed, comes back to the Patent Office, and, under the pretence of inadvertence and mistake in the first specification, gets inserted into reissued letters all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the office reversed, steals a march on the public, and on those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title. We have more than once expressed our disapprobation of this practice. As before remarked, we consider it extremely doubtful whether reissued letters can be sustained in any case where they contain claims that have once been formally disclaimed by the patentee, or rejected with his acquiescence, and he has consented to such rejection in order to obtain

his letters-patent. Under such circumstances, the rejection of the claim can in no just sense be regarded as a matter of inadvertence or mistake. Even though it was such, the applicant should seem to be estopped from setting it up on an application for a reissue.

CONCLUSION

It is respectfully submitted that the petition for certiorari should be denied.

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JUNE 1950.

☆ U. S. GOVERNMENT PRINTING OFFICE: 1950 899904 727